

JUN 11 2004

OFFICIAL

Attorney Docket # 34250-20CPA

Patent

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Peter J. Miller

Serial No.: 09/578,882

Filed: May 26, 2000

For: Imaging System Using Color  
Sensors and Tunable FiltersExaminer: Genco, B. C.  
Group Art: 2615I hereby certify that this correspondence is being  
facsimile transmitted to the U. S. Patent and  
Trademark Office (Fax No. **(703) 872-9306**),  
onJune 11, 2004  
(Date of Deposit)Tender J. [Signature]  
Name of applicant, assignee or registered representative

Signature

June 11, 2004  
Date of Signature**VIA FACSIMILE: (703)872-9306****RESPONSE TO REQUIREMENT FOR ELECTION OF SPECIES**

SIR:

It is believed no fees or charges are due at this time; however, if any fees or charges are required at this time in connection with the application, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

In response to the Requirement for Election of Species dated May 13, 2004, applicant submits as follows:

Applicant elects *with traverse* Species I (Figure 1) and Species C (ECB type cell) on which Claim 7 reads. The choice of Species I and Species C with Claim 7 reading thereon is being made only to fulfill the requirement under 37 CFR §1.143 that the applicant must respond to the Election

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Amdt. dated June 11, 2004  
Reply to Election Requirement dated May 13, 2004

Requirement. Applicant reserves the right to pursue the non-elected claims in a divisional application prior to issuance of a patent on the instant application.

Applicant requests that the Examiner clarify the meaning of having two different sets of species (Species I-II-III and Species A-B-C-D-E-F). It is assumed that the intent of the Examiner is to indicate that there are eighteen (18) separate species, since the Examiner noted "that within each of the above noted species I-III [there are] claims directed to" each of Species A-B-C-D-E-F (Office Action, page 2). Please confirm this. If this is incorrect, please clarify the relationship between the two sets of species and the exact number of species alleged in the present application.

It should be noted that the term "generic" must be qualified when there are two different sets of species. For example, Claims 1-11, 15-20, 23-26, and 29 are generic to Species I-II-III, while Claims 1-4, 9-17, 21-22, and 24-28 are generic to Species A-B-C-D-E-F. Claims 1-4, 9-11, 15-17, and 24-26 are generic to *both* Species I-II-III and Species A-B-C-D-E-F. Furthermore, the terms "reading upon" or "reading on" should be qualified in a similar way. For example, Claim 7 which reads on Species C, is nonetheless generic to Species I-II-III. As another example, Claim 14, which reads on Species I, is generic to Species A-B-C-D-E-F.

Applicant traverses the Election of Species Requirement for the following reason. There are two criteria for making a proper Restriction Requirement (see MPEP §803.01):

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the Examiner to examine the inventions.

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Applicant makes no comment or assertion concerning whether the Examiner has satisfied criteria (A); however, applicant traverses the Restriction Requirement because the Examiner has failed to make a *prima facie* showing of a serious burden, i.e., criteria (B). As stated in the MPEP, a serious burden may be *prima facie* shown by the Examiner "by appropriate explanation of separate classification, or separate status in the art, or a different field of search" (MPEP, §803.01). Because the Examiner has failed to show any of these, or even to make any statement concerning the serious burden criteria, the Examiner has not made a proper Restriction Requirement.

Although applicant has provisionally elected an alleged species as required by 35 U.S.C. §121, applicant respectfully traverses the requirement and requests reconsideration and withdrawal of the Election Requirement under 37 C.F.R. §1.143, in light of the arguments made above.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN &amp; PAVANE

By 

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Dated: June 11, 2004

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Pages: **4 (including this page)**Date: **June 11, 2004**  
Our File: **34250-20CPA**

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☐ Confirmation Will Follow☒ Confirmation Will Not Follow

Notes/Comments:

**RESPONSE TO**  
**ELECTION OF SPECIES REQUIREMENT**  
**FOR U.S. PAT. APP. SER. NO. 09/578,882**

Contents: **3 pages of Response**

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